



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,782	04/02/2004	Sang-Ki Nam	20016/0201129-US0	9964

7278 7590 03/21/2005

DARBY & DARBY P.C.
P. O. BOX 5257
NEW YORK, NY 10150-5257

EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT PAPER NUMBER

3711

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/816,782

Applicant(s)

NAM, SANG-KI

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,7-12,14,16,17,21-25 and 29-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,13,15 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 26-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/13/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 2-3, 7-12, 14, 16-17, 21-25, and 29-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 18 February 2005. The argument that it would not be a burden to search all the species is disagreed with. The species would require different type of word searches in order to properly examine each of them. As such the restriction is proper and is final.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Shira.

Shira discloses a golf club head comprising a first portion (Figs. 1-2, Ref. No. 2) having one inclined surface and at least one arcuate surface (Figs. 1-2, Ref. No. 10,

Art Unit: 3711

Col. 4, Lns. 40-45), a second portion (Figs. 1-2, Ref. No. 4), and friction welding (Col. 4, Lns. 1-10).

4. Claims 1 and 4-6, 13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeda (5,769,307).

Takeda discloses a golf club head having a first metal material of a first portion of a heel being steel and a second material of a second portion of a hosel being a titanium alloy (Col. 4, Lns. 65 through Col. 5, Lns. 5) and friction welding (Col. 5, Lns. 50-62).

In an apparatus claim weight is given to what an apparatus is and not how it is formed. Very little weight is given to the structure of the surfaces prior to friction welding the portions together due to the structure not being present after the head is formed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shira in view of 2003-25075 and Goto.

2003-25075 discloses surfaces being friction welded together having a Ra surface roughness being a Ra value of 10 or less. Goto discloses Ra values having

Art Unit: 3711

units of micrometers [0036]. In view of the reference 2003-25075 it would have been obvious to have a surface roughness smaller than Ra 25 in order to use a Ra value used in the market place for friction welding surfaces together. In view of the reference of Goto it would have been obvious to include the units of micrometers to a Ra value in order to utilize units for Ra values used in the market place.

7. Claims 1, 13,15, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda in view of 54-112760 and Office Notice.

Takeda discloses a golf club head and a method of forming a head having a first metal material of a first portion of a heel being steel and a second material of a second portion of a hosel being a titanium alloy (Col. 4, Lns. 65 through Col. 5, Lns. 5) and friction welding (Col. 5, Lns. 50-62).

Takeda lacks one of at least one inclined surface and at least one arcuate surface. 54-112760 discloses one inclined surface (Figs. 6-8, DERWENT-ACC-NO: 1979-74435B, Basic Abstract). In view of the reference 54-112760 it would have been obvious to modify the head and process of forming a head of Takeda to have a first portion with one inclined surface in order to utilize the a known method in the market place of shaping surfaces which are going to be friction welded together.

The examiner takes Official Notice that it is well known to surface finish a weld joint and it would be obvious to do so to make the joint visually pleasing to a golfer.

Allowable Subject Matter

8. Claims 26-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. With respect to claims 26-28, none of the prior art discloses or renders as obvious a method for manufacturing a golf club head having a conic first inclined surface section and a second inclined surface section surrounding the conic first inclined surface section and at an angle with the conic first inclined surface section in addition to the other elements of structure claimed.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 9 March 2005


STEPHEN BLAU
PRIMARY EXAMINER